

Remarks

I. Introduction

With the addition of new claim 7, claims 4 to 7 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited references.

II. Rejection of Claims 4 to 6 Under 35 U.S.C. 102(b)

The Office Action rejects claims 4 to 6 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 1,251,065 ("McCain"). Applicant respectfully submits that claims 4 to 6 are not anticipated by McCain and requests that the rejection be withdrawn.

Claim 4 relates to a drive bearing for printing machines for coupling a rotating tool to a drive shaft of a servomotor. Claim 4 recites that the drive bearing includes an element located at an interface between the rotating tool and the drive shaft on a tool axis. Claim 4 recites that the element has an axially projecting coupling cone that engages a counter recess of the drive shaft. Claim 4 also recites that the cone is releasably held in the recess by frictional engagement. Claim 4 also recites that an angular position of the element is adjustable, and that the element is centered and configured to be secured to prevent rotation.

McCain relates to "shaft couplings permitting angular adjustment of one shaft or shaft section relative to another." Page 1, lines 8 to 11. With respect to claim 4, the Office Action states that "McCain discloses a drive bearing capable of being used in printing machines for coupling a rotating tool to a drive shaft of a servomotor comprising an element 18 located at an interface between the tool 11 and the drive shaft 12 on a tool axis, the element having an axially projecting coupling cone 24 that engages a counter recess 21 of the drive shaft, the cone being releasably held in the recess by frictional engagement against nuts 25 wherein an angular position of the element is adjustable (col. 1, 1.9-11), and wherein the element is centered

and configured to be secured to prevent rotation.” Office Action at page 2.

Applicant respectfully maintains that claim 4 is not anticipated by McCain because, for example, McCain does not disclose or even suggest all of the limitations recited in claim 4. For example, McCain does not disclose or even suggest an element located at an interface between the rotating tool and the drive shaft, the element having an axially projecting coupling cone that engages a counter recess of the drive shaft and that is releasably held in the recess by frictional engagement, as recited in claim 4. The Specification states at page 4, lines 2 to 5 that “[e]ach tool is provided with connecting cone 20 and is inserted into cone shaped recesses 24 of drive shafts 21 and precisely centered therein.” The Specification further states at page 4, lines 9 to 11 that “[t]he coupling occurs by frictional engagement between the surfaces of cone 20 and cone shaped recess 24 in that coupling cone 20 is tightened...”. As an initial matter, McCain does not describe an element located at an interface between the rotating tool and the drive shaft. Rather, McCain describes that “for the purposes of this invention therefore the shaft 12 and the member 18 are the two members that are to be coupled and may be considered as separate shaft members or sections, either of which may constitute the driving member.” Page 1, lines 67 to 72. McCain further describes that a front cover of a crank case 11 is “secured in place.” Page 1, line 47. Thus, the Office Action incorrectly identifies the crank case cover 11 as being a rotating tool, when in fact, the crank case cover 11 is secured in place. To the extent that the member 18 in McCain could be considered as a rotating element with respect to the shaft 12, there is no element located at the interface between the shaft 12 and the member 18 because the shaft 12 and the member 18 are in direct contact with each other. Furthermore, while nuts 25 and bolts 28 are located in a socket 19, the conical outer surfaces 27 of the nuts 25 merely serve to press together the shaft 12 and the member 18 in an angularly set position, and therefore do not constitute an axially projecting coupling cone that engages a counter recess of the drive shaft and that is releasably held in the recess by frictional engagement as recited in claim 4.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913,

1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that McCain does not disclose, or even suggest, an element located at an interface between the rotating tool and the drive shaft, the element having an axially projecting coupling cone that engages a counter recess of the drive shaft and that is releasably held in the recess by frictional engagement as recited in claim 4. It is therefore respectfully submitted that McCain does not anticipate claim 4.

Additionally, to reject a claim under 35 U.S.C. § 102, the Examiner must demonstrate that each and every claim limitation is contained in a single prior art reference. See, Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See, Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the reference relied upon would not enable a person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above. Also, to the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art." See M.P.E.P. § 2112; emphasis in original; and see, Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, the anticipation rejection as to the rejected claims must necessarily fail for the foregoing reasons.

In summary, it is respectfully submitted that McCain does not anticipate claim 4, and Applicant respectfully requests that the rejection of this claim be withdrawn.

As for claims 5 and 6, which depend from claim 4 and therefore include all of the limitations of claim 4, it is respectfully submitted that McCain does not anticipate these dependent claims for at least the same reasons given above in support of the patentability of claim 4, and Applicant respectfully requests that the rejection of

these claims be withdrawn also.

III. New Claim 7

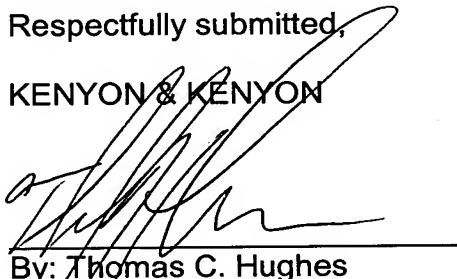
New claim 7 has been added herein. It is respectfully submitted that new claim 7 does not add any new matter and is fully supported by the present application, including the Specification. It is respectfully submitted that this claim is allowable.

IV. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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